

REMARKS/ARGUMENTS

Applicants respectfully request entry of this Amendment, reconsideration of this application as amended, and reconsideration of the Final Office Action dated November 29, 2006.

I. General Remarks Regarding the Content of this Amendment

Upon entry of this Amendment, claims 1-4, 6, 9, 10, 12-21, 24, 26, 27, 34-37, 39, 42, 43, 45-53, 56, and 58 will remain pending in this application. By this Amendment, independent claim 1 has been amended to recite the subject matter of dependent claims 7 and 8 (these dependent claims have been canceled), and independent claim 34 has been amended to recite the subject matter of dependent claims 40 and 41 (these dependent claims have been canceled). The other claims have been amended, where necessary, based on the changes made to independent claims 1 and 34 (*i.e.*, claim 9 is amended to depend from claim 1, claim 42 is amended to depend from claim 34, and the step labeling has been amended in claim 43). No new matter is included in this Amendment, and no additional claim fees are due as a result of this Amendment.

Also, because this Amendment simply moves subject matter from various dependent claims into the independent claims, Applicants respectfully submit that no new issues are raised by this Amendment that would require further searching and/or consideration by the Examiner.

As noted above, various claims have been canceled from this application and certain claims have been amended. Applicants make these changes without prejudice or disclaimer. While Applicants do not necessarily agree with or acquiesce in the grounds of rejection raised with respect to any claims in this application, in order to expedite prosecution and to facilitate allowance of this application, Applicants make these claim changes in the present application. Applicants present these changes solely for the purposes of expediting prosecution and facilitating the immediate allowance of this present application. Applicants reserve all rights to pursue claims of the same or similar scope to the original and/or canceled claims in this application, *e.g.*, by filing a continuing application.

II. The Claims Patentably Distinguish from the Cited Schilit Patent

The Office rejected claims 1-4, 6-10, 12-21, 24, 26, 27, 34-37, 39-43, 45-53, 56, and 58 under 35 U.S.C. § 102(e) as allegedly anticipated by Schilit, et al., U.S. Patent No. 6,687,876 (hereinafter “Schilit”). See the Final Office Action at pages 2-10. Applicants respectfully traverse this rejection and request reconsideration.

As an initial matter, Applicants respectfully submit that these claims are patentable for the reasons raised in the September 21, 2006, Amendment. These arguments are incorporated by reference. The following presents additional reasons and/or expands on previously presented reasons in favor of patentability for the present claims.

To anticipate a claim, the cited reference must teach each and every element of the claim. Moreover, the identical invention must be disclosed in as complete detail as is contained in the claim, and the various claimed elements must be arranged in the same manner as required by the claim. See *The Manual of Patent Examining Procedure*, § 2131 and the cases cited therein. As will be demonstrated below, the Schilit patent fails to anticipate Applicants’ claimed invention.

Applicants’ claim 1 recites a method for processing electronic data that includes: (a) parsing at least a first portion of a base portion of an electronic document; (b) creating a first context node associated with the first portion, wherein the first context node includes information identified during the parsing of the first portion; (c) parsing at least an annotation to the base portion; (d) creating a second context node associated with the annotation to the base portion, wherein the second context node includes information identified during the parsing of the annotation, wherein the annotation includes electronic ink data, and wherein the first context node and the second context node are arranged in a single hierarchical data structure representing data associated with the electronic document; and (e) linking the second context node with the first context node. Schilit does not teach or suggest this claimed method.

The Office has not carried its burden of establishing that Schilit discloses the invention as defined in Applicants’ claim 1. Rather, the Office simply looks at individual parts of Applicants’ claims, in a vacuum, and points to diverse areas of Schilit that allegedly relate to these individual parts of the claims, without considering Applicants’ claims as a whole and/or in context. As

noted above, for anticipation to exist, the identical invention must be disclosed in the cited reference in as complete detail as is contained in the claim, and the various claimed elements must be arranged in the same manner as required by the claim. *See* the *M.P.E.P.* § 2131 and the cases cited therein. The Office does not carrying its burden of establishing that Applicants' claim 1 is anticipated by Schilit simply by finding some portion of Schilit that may relate to parsing, some portion that may relate to electronic ink, and some portion that may relate to hierarchical data structures. Rather, to anticipate, Schilit must include all of the features of Applicants' claims arranged in the same manner as recited in the claim. Schilit clearly fails this test.

Applicants' claim 1 recites parsing a first portion of a base portion of an electronic document and creating a first context node associated with this first portion based on information identified during the parsing. The claim further recites parsing an annotation to the base portion and creating a second context node associated with the annotation based on information identified during this parsing. In rejecting Applicants' claim 7 (the subject matter of which is now included in independent claim 1), the Office points to column 10, lines 15-20, column 10, lines 65-67, and column 11, lines 30-33 in Schilit. *See* the Final Office Action at page 4. In rejecting Applicants' claim 8, which depended from claim 7 (and the subject matter of which is now included in independent claim 1), the Office points to these same portions of Schilit. *Id.* at 4-5. Applicants respectfully submit that this portion of Schilit cannot perform double duty as required by the Office's interpretation of Schilit (as applied to Applicants' claims), *i.e.*, it cannot (and does not) disclose: (a) parsing a portion of an underlying electronic document, (b) creating a first context node based on this parsing, (c) parsing an annotation to this base portion, and (d) creating a second context node based on this parsing.

Claim 1 has further distinguishing features from the method described in Schilit. As noted above, Applicants' claim 1 further recites that the first and second context nodes, one associated with the base portion of the electronic document and one associated with the electronic ink annotation, are arranged in a single hierarchical data structure representing data associated with the electronic document. In rejecting Applicants' claim, the Office points to column 8, lines 29-36 and column 15, lines 23-40 in Schilit. *See* the Final Office Action at page

3. Column 8 of Schilit describes that anchors determined for freeform digital ink annotations are mapped to the object structure of a view underlying the digital ink annotations. It then mentions that the mapping may be to hierarchical object structures such as characters, phrases, and paragraphs. Column 15 of Schilit simply describes that the Schilit invention may be applied to electronic books or document readers that display changing views. Nothing in these portions, however, teaches or suggests creating a first context node based on information obtained from parsing a portion of an electronic document, creating a second context node based on information obtained from parsing an annotation to that document, and storing these context nodes in a single hierarchical data structure, as recited in Applicants' claim 1. Even if one were to assume that the Schilit system and method used some type of underlying hierarchical data structure for an electronic document, there is nothing in the patent that teaches or suggests storage of context nodes from parsing both the underlying document and the annotation in a single hierarchical data structure, as recited in Applicants' claim 1. Accordingly, Schilit fails to anticipate Applicants' claim 1 for this additional reason.

Claim 34 contains features similar to those described above with respect to claim 1. Applicants respectfully submit that claim 34 and its associated dependent claims are allowable for the same reasons as described above with respect to claim 1.

Applicants' independent claim 18 also patentably distinguishes from Schilit. This claim recites a computer-implemented method for processing data including electronic ink data that includes: (a) parsing a first data set containing data associated with a base document; (b) parsing a second data set that includes unclassified electronic ink data; (c) storing results from parsing the first and second data sets as a data structure on a computer-readable medium, wherein the data structure includes context nodes associated with the first and second data sets in a single hierarchical arrangement; and (d) linking at least some portion of the second data set with at least some portion of the first data set.

As described above in connection with claim 1, Schilit does not teach or suggest storing context nodes obtained as a result of parsing two data sets (one of which includes electronic ink data and one of which includes data relating to a base electronic document) as a data structure,

wherein the data structure includes context nodes associated with the first data set and the second data set in a single hierarchical arrangement, as recited in Applicants' claim 18. Schilit provides no information regarding the underlying data structure used for storing any parsing results. In addressing this claim feature, the Office points to column 8, lines 29-36 and column 15, lines 23-40 in Schilit. *See* the Final Office Action at pages 9-10. Column 8 of Schilit describes that anchors determined for freeform digital ink annotations are mapped to the object structure of a view underlying the digital ink annotations. It then mentions that the mapping may be to hierarchical object structures such as characters, phrases, and paragraphs. Column 15 of Schilit simply describes that the Schilit invention may be applied to electronic books or document readers that display changing views. Nothing in these portions of Schilit, however, teaches or suggests storing context nodes based on information obtained from parsing the electronic document and electronic ink data in a single hierarchical data structure arrangement, as recited in Applicants' claim 18. Even if one were to assume that the Schilit system and method used some type of underlying hierarchical data structure for an electronic document, there is nothing in the patent that teaches or suggests storage of context nodes obtained from parsing both the underlying document and the electronic ink in a single hierarchical data structure, as recited in Applicants' claim 18. Accordingly, Schilit fails to anticipate Applicants' claim 18.

Claim 50 generally parallels claim 18, and Applicants respectfully submit that this claim and its associated dependent claims are allowable for the same reasons as described above with respect to claim 18.

Applicants' claims 12, 26, 45, and 58 depend from claims 1, 18, 34, and 50, respectively, and these dependent claims further recite that various claim-identified context nodes share at least one common parent node in the overall single hierarchical data structure or arrangement. In addressing these claims, the Office points to column 4, line 66 through column 5, line 3 in Schilit. *See* the Final Office Action at pages 6 and 9. This cited portion of Schilit is reproduced below:

In response to these edits, the text that has been annotated at 54 now flows across two lines and the "cross-out" freeform digital ink annotation 54 flows along with

the underlying text objects to continue to indicate the logical relationship between the “cross-out” freeform digital ink annotation and the underlying text objects.

See Schilit at column 4, line 65- through column 5, line 3. This portion of Schilit, at best, describes a desired final visual effect of use of the Schilit invention. Nothing in this portion of Schilit teaches or remotely describes any feature of any underlying data structure(s) that may be used to accomplish the desired effect. This disclosure of Schilit falls far short of anticipating the various features of the data structure recited in Applicants’ claims 12, 26, 45, and 58 (e.g., that context nodes relating to the underlying electronic document and an electronic ink annotation thereto share a common parent node in an overall single hierarchical data structure or arrangement). The rejection of these claims as anticipated by Schilit is clearly deficient and should be withdrawn.

Because the claims not specifically addressed above depend, either directly or indirectly, from one of claims 1, 18, 34, and 50, Applicants respectfully submit that these claims are allowable at least for the same reasons that make their respective independent claims allowable.

In view of the foregoing, Applicants respectfully submit that Schilit fails to anticipate the claims in this application and that these claims patentably distinguish from Schilit. Withdrawal of this rejection and allowance of these claims are earnestly solicited.

III. Conclusion

If the Examiner believes that a telephone conference or a personal interview will be useful to advance the prosecution of this application and/or place the application in condition for allowance, he is invited to contact the undersigned attorney by telephone.

Applicants believe that no fees are due to enable entry and consideration of this Amendment. If, however, the Office determines that any fees are required, such as fees under 37 C.F.R. §§ 1.16 or 1.17, or if an extension of time is necessary that is not accounted for in the papers filed with this Amendment, the Commissioner is authorized to debit our Deposit Account No. 19-0733 for any necessary fees, including any necessary extension fees or other fees needed to maintain the pendency of this application.

Application of Richard Duncan, et al. – U.S. Patent Appln. No. 10/644,900
Amendment Under 37 C.F.R. § 1.116 dated January 29, 2007

All rejections having been addressed, Applicants respectfully submit that this application is in condition for immediate allowance and respectfully solicit prompt notification of the same.

Respectfully submitted,
BANNER & WITCOFF, LTD.

By: /William F. Rauchholz/
William F. Rauchholz
Reg. No. 34,701

BANNER & WITCOFF, LTD.
Eleventh Floor
1001 G Street, N.W.
Washington, D.C. 20001-4597
(202) 824-3000 (Telephone)
(202) 824-3001 (Facsimile)

Dated: January 29, 2007